

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Application No.: 09/682,924
Applicant: Baur et al.
Filing Date: November 1, 2001
Title: **SELF-TEST FOR LEAKAGE
CURRENT OF DRIVER/
RECEIVER STAGES**

Atty. Docket: DE9-2000-0072-US1
Today's Date: March 25, 2002
Examiner: Ian Lobo

Licensing and Review

FAX: 703-305-7658

#3
Reg for Recm
4-10-02

**Request for Reconsideration of Petition
for Retroactive License**

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Decision on Request Under 37 C.F.R. 5.25 dated January 25, 2002, Applicants respectfully request reconsideration of the denied Petition for Retroactive License in view of the remarks that follow. No fee is due by virtue of this response. However, if the PTO determines that a fee is due, please charge Applicant's Deposit Account, 09-0456.

CERTIFICATE OF MAILING

I hereby certify that, on the date shown below, this correspondence is being:

MAIL

☐ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant commissioner of Patents, Washington, DC 20231.

Date: MARCH 25, 2002

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☒ transmitted by facsimile to the Patent and Trademark Office.

ANTHONY J. CANALE

Name

Anthony J. Canale

Signature

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Examiner states that the petition is denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met. Examiner states that Declarants have not established error.

Applicants respectfully request reconsideration of the petition for Retroactive License under 37 C.F.R. 5.25 based on the remarks that follow.

As stated in the Verified Statements by Applicants' German attorneys, Jan Gigerich, Thomas Reinhardt and Dr. Wolfgang Kauffmann, the invention was originally disclosed to the Intellectual Property Department in Germany and Applicants' German attorneys believed that the invention was not made in the U.S. As such, Applicants' German attorneys did not believe that a foreign filing license under 37 C.F.R. 5.11 was required since they believed the invention was not made in the United States. The error occurred in that Applicants' German attorneys did not contact Applicants' U.S. attorney, Robert A. Walsh, to notify him that there were U.S. inventors on a case for filing in the European Patent Office.

It was not until October 3, 2001, during preparation of the case for filing with the United States PTO, that Applicants' U.S. attorney, Robert A. Walsh, became aware that two of the inventors were U.S. citizens. In order to avoid any future issues which may arise related to which country the invention was made, Mr. Walsh proceeded to seek a Retroactive License under 37 C.F.R. 5.25 as a preventative measure.

The undersigned has been in contact with the Applicants' German attorneys and have established a procedure that whenever a citizen of the United States is named as a co-inventor, a German attorney is to contact a U.S. attorney before filing a patent application in any country. Using this procedure, future possible errors may be avoided.

If the Examiner decides that no Retroactive License is required in the above identified patent application, then Applicants will withdraw the Petition for Retroactive License without prejudice.

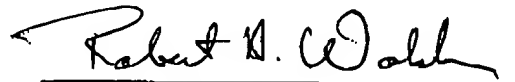
In light of the foregoing remarks, Applicants respectfully request that the outstanding denial of the petition be withdrawn.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this petition.

Respectfully Submitted,

For: Baur et al.,

By:



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